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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,260	06/25/2003	David Vincent Zyzak	9114ML	4525
27752	7590	05/18/2006		
THE PROCTER & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION WINTON HILL TECHNICAL CENTER - BOX 161 6110 CENTER HILL AVENUE CINCINNATI, OH 45224			EXAMINER HENDRICKS, KEITH D	
			ART UNIT	PAPER NUMBER
			1761	
DATE MAILED: 05/18/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,260

Applicant(s)

ZYZAK ET AL.

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

i) The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a) The specification provides support for a method for removing (and optionally enzymatically altering) asparagine, from snack chips and French fries. The specification does not provide support for the production of such wherein the snack chips or French fries have “been treated with an enzyme such that the resulting snack chips have a lower level of acrylamide than snack chips made from similar ingredients in a similar process.” The specification does not describe or provide support for the production of the claimed invention via any “similar process”, with “similar ingredients”. The specification does not describe any such similar processes or products, nor does it enable one skilled in the art to ascertain the metes and bounds of the claimed invention with regard to these phrases. Applicant appears to have added the material to the claims in the latest amendment, yet has not referred to any passage within the specification which would provide support for such language.

(Note that, while not required, it is always helpful and suggested that upon amendments to the claims, applicant provide a simple reference to the passage(s) in the specification where support for the amendments may be found. Such measures would assist the examiner in making accurate determinations of claim support and avoid potentially unnecessary new matter-type rejections.)

b) The specification provides support for the addition of an asparaginase to the starting food material, in order to act upon the asparagine present in such material. However, there is no enzyme disclosed in the specification which actually acts upon or reduces *acrylamide* in any way (only that which may act upon asparagine). One skilled in the art would not be apprised of how to make and use the claimed invention, given the inadequate written description in the specification with regard to this

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claimed feature. It is noted that the claimed phrase does not even require that the broadly-recited "enzyme" actually facilitate in the stated "reduction" of acrylamide; at best, applicant's claims appear to imply that the enzyme may be involved, in a roundabout manner. This, again, is inaccurate and not supported by the specification.

It is further noted that said addition of "an enzyme" (i.e. asparaginase) does not appear to be the crux of applicant's invention, given the teachings of the specification with regard to the extraction processes described therein, and the fact that the instant claims are actually directed to an "article of commerce" comprising a container and snack chips or French fries.

ii) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-14 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "reduced", in product/article claims 5 and 12, is a relative term which renders the claims indefinite. The term "reduced" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The rejection is incorporated as cited in a previous Office action.

Applicant's arguments filed March 07, 2006, have been fully considered but they are not persuasive.

At page 4 of the remarks, applicant states that the claims are "are amended to implicitly state that which was implicit in the claims as originally filed. Specifically, the reduction in acrylamide in snack chips or French fries is relative to the same basic chip or fry that was not treated to reduce the level of acrylamide." Applicant's claims, however, have been amended to add the phrase wherein the snack chips or French fries have "been treated with an enzyme such that the resulting snack chips have a lower level of acrylamide than snack chips made from similar ingredients in a similar process." Initially, these two statements are *not* equivalent, and do not convey the same meaning. Applicant's arguments are not commensurate in scope with the claimed invention. Secondly, the amended phrase does not serve to clarify the claimed invention, and has in fact further complicated the issue.

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In addition to the term "reduced" and the rejection previously stated of record, and herein incorporated as cited previously of record, the following rejections are made with regard to these claims:

The term "similar" is a relative term which renders the claims indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Regarding the phrase "similar ingredients", it is unclear as to (a) which "similar" ingredients applicant's claims refer, (b) how many ingredients may be switched, (c) what properties need be considered in order to make another ingredient "similar", and (d) to what degree of "similarity" these ingredients must be in order to meet the claim limitations. Also, the phrase "similar process" is indefinite, as it is unclear as to (a) what steps would be required to make a similar product, especially considering that the claims are directed to an article of commerce comprising a container and snack chips, (b) to what degree of "similarity" these steps must be, and (c) what properties of a process step are considered in order to make it "similar" to another.

Further, the claimed phrase does not even require that the broadly-recited "enzyme" actually facilitate in the stated "reduction" of acrylamide. Thus the claimed phrase is disjointed. Still further, it is again noted that there is no enzyme disclosed in the specification which actually acts upon or reduces *acrylamide* in any way (only that which may act upon asparagine).

Despite applicant's statement that the claims are "amended to implicitly state that which was implicit in the claims as originally filed", the claims remain unclear in light of the latest amendment. The fact that applicant is unable to find and incorporate clear and proper support from the specification is further evidence that the specification does not provide the necessary support or details for the claimed invention with regard to the term "reduced," and that the term was not "implicitly" defined or supported in the specification or claims as originally filed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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i) Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroeder et al. (US PAT 4,272,554). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed March 07, 2006, have been fully considered but they are not persuasive. At page 4 of the remarks, applicant states that due to the amendment, "the claims require that the acrylamide reduction be accomplished by treatment with an enzyme", and that "Schroeder et al. does not teach or suggest the use of enzymes, or the reduction of acrylamide in a snack chip."

This is not deemed persuasive for the reasons of record. Contrary to applicant's statement that the claims "require that the acrylamide reduction be accomplished by treatment with an enzyme", this statement is not commensurate in scope with the language of the claims. The claimed phrase does not require that the broadly-recited "enzyme" actually facilitate in the stated "reduction" of acrylamide; at best, applicant's claims appear to imply that the enzyme may be involved, in a roundabout manner. Importantly, as stated above with respect to the 35 U.S.C. 112, first paragraph rejection, there is no enzyme actually disclosed in the specification which acts upon or reduces *acrylamide* in any way (rather, only that which may act upon asparagine). It is further noted that said addition of "an enzyme" (i.e. asparaginase) does not appear to be the crux of applicant's invention, given the teachings of the specification with regard to the extraction processes described therein, and the fact that the instant claims are actually directed to an "article of commerce" comprising a container and snack chips or French fries.

As previously stated on the record, the Schroeder et al. reference describes a product which meets the claimed limitations which are actually supported by the instant specification. A recitation of the intended method of making the claimed invention (i.e. "product by process" type claims) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure would inherently possess the same claimed properties (i.e. "lower level of acrylamide than snack chips made from similar ingredients in a similar process"), then it meets the claim.

ii) Claims 5-14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Elder et al. (Pub. No. US 2004/0058054). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed March 07, 2006, have been fully considered but they are not persuasive. At pages 5-6 of the response, applicants state that the examiner has not given proper weight to the claim limitations regarding the written message and container as recited in the claims.

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This is not deemed persuasive for the reasons of record. Initially, regarding the container as part of the claimed invention, this has been addressed of record. See page 5 of the June 30, 2004 Office action.

Regarding the particular message “associated with the container” (unclear whether typed, written, scribbled or encoded, and whether this is actually present on the container, or perhaps somewhere on a display shelf near the container, i.e. “associated with” such), this, too, has been addressed of record. See page 5 of the June 30, 2004 Office action. As stated therein, regarding claims 5-14, it would have been obvious to one of ordinary skill in the art to have packaged and appropriately labeled the food products produced by Elder et al. Packaging and labeling techniques were well-known and common in the art, especially regarding any potential special feature that might draw the interest of the consumer. Regarding the particular message, it is noted that the printed word itself would not significantly change the claimed article of matter, and would not provide a patentable distinction, *per se*, over the known prior art package materials and methods.

This statement does not imply in any way that the examiner failed to consider this part of the claimed invention. In fact, by addressing the point in the first Office action, this demonstrates that such was indeed considered. Thus applicant’s statements are inaccurate and misleading.

Applicant refers to two court cases which address certain issues with regard to printed matter on an article. However, neither of these are on point with regard to the instant claims, and are not relevant to the issue at hand. The printed matter on the label of the container is not integral to the function of the claimed article, for example, as opposed to the situation in *In re Miller* as cited by applicant, where the printed matter serves as an indicator for measurement, thus affecting the use and function of the article as a whole. Such is simply not the issue in the instant case. A simple message on the claimed article of commerce would not alter or change the tangible, material functions of the article, namely those involving the snack chips (or fries) and the container. A message “informing the consumer that the snack chips have a reduced level of acrylamide” would not functionally or significantly alter the article, and would not patentably differ from the same article with a message of “tasty chips” written on a label, for example. While the words on the container may describe that which is in the container, they do not provide any actual function related to the container or snack chip therein. The mere arrangement of the words on a container, as applicant has claimed, do not amount to a functional property of the invention.

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Finally, applicant is referred to MPEP 2112.01, part III, which states

where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, **>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.").

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

i) Claims 5-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-14 of copending Application No. 10/603,978.

Applicant's arguments filed March 07, 2006, have been fully considered but they are not persuasive. Applicant's comments reflect those presented previously on the record. This is not deemed persuasive, and the rejections are maintained for the reasons of record.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KEITH HENDRICKS
PRIMARY EXAMINER